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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,634	09/19/2003	William B. Ardern II	ARD-101US	5073
24314	7590	06/13/2006	EXAMINER	
JANSSON, SHUPE, MUNGER & ANTARAMIAN, LTD 245 MAIN STREET RACINE, WI 53403				HOGE, GARY CHAPMAN
		ART UNIT		PAPER NUMBER
				3611

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/664,634	ARDERN, WILLIAM B.
	Examiner Gary C. Hoge	Art Unit 3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 March 2006.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-15 and 17-35 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15 and 17-35 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 33 is objected to because of the following informalities: on line 2, it appears that “polyethylene” has been misspelled. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Manley (D479,146).

See Fig. 1. Manley discloses a tri-panel binder clip sleeve, the binder clip comprising first and second resilient jaw portions, a connecting spine portion therebetween and an outer surface along each of the jaw and spine portions, the binder clip further having a handle secured to each of the jaw portions such that pressing together of the handles separates the jaw portions, the tri-panel binder clip sleeve comprising a first panel in overlying relationship with the first jaw portion outer surface, the first panel having an outwardly-facing surface, a second panel in overlying relationship with the second jaw portion outer surface, and a third panel spaced between and connecting the first and second panels, the third panel being in overlying relationship with the spine portion and having an outwardly-facing surface. The recitation that

the outwardly-facing surfaces are “for displaying indicia located thereon” is merely a statement of intended use. It is noted that the tri-panel binder clip sleeve disclosed by Manley does not cover the handles; a separate component does. Therefore, the tri-panel binder clip sleeve disclosed by Manley anticipates the claim(s).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 6-12, 15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manley (D479,146).

Regarding claims 2, 10 and 15, Manley discloses the invention substantially as claimed, as set forth above. However, the panels appear to be slightly larger than the outer surfaces of the clip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the panels the same size as the outer surfaces of the clip because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 6, 8, 9 and 18, Manley discloses the invention substantially as claimed, as set forth above. However, it is not known what material is used to make the sleeve. Because it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having

ordinary skill in the art would know that paper, plastic or vinyl would be suitable for the fabrication of a sleeve, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the sleeve disclosed by Manley from paper, plastic or vinyl as a matter of choice in design, based on such factors as cost and availability of the materials to the designer.

Regarding claims 7, 11 and 19, Manley discloses the invention substantially as claimed, as set forth above. However, it is not known whether an adhesive assists in securing the sleeve to the clip. Nevertheless, it is well known to use an adhesive to secure one thing to another and it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an adhesive between the sleeve and the clip, in order to attach the sleeve to the clip more securely. It was also well known to apply adhesive to the entire face of a thing being adhered thereby, and it would have been obvious to apply the adhesive to the whole surface of the sleeve, in order to maximize the adhesion of the adhesive.

Regarding claims 12, 17 and 20, see Figs. 1 and 2.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manley (D479,146), as applied to claim 7, above, and further in view of Bennett et al. (5,522,586).

Manley discloses the invention substantially as claimed, as set forth above. However, although the sleeve is folded in two places, it apparently does not include a perforation to assist in the folding. Bennett teaches (col. 2, lines 56-59) that it was known in the art to provide a perforation to assist in the folding of a sheet.

7. Claims 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manley (D479,146) in view of Will et al. (5,766,795).

Manley discloses the invention substantially as claimed, as set forth above. However, the sleeve apparently does not include a transparent protective layer. Will et al. teaches (see the Abstract) that it was known in the art to provide a transparent protective layer on a label. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the sleeve disclosed by Manley with a transparent protective layer, as taught by Will, in order to protect the sleeve.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manley (D479,146) in view of Antinone (6,327,749) and Lasprogata (5,839,215).

Manley discloses the invention substantially as claimed, as set forth above. However, Manley does not disclose indicia on the sleeve. Antinone teaches that it was known in the art to provide indicia on a sleeve of the type disclosed by Manley. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the sleeve disclosed by Manley with indicia, as taught by Antinone, in order to advertise the subject matter of the indicia. Further, Antinone does not disclose using raised indicia. Lasprogata teaches that it was known in the art to use raised indicia. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the indicia on the sleeve disclosed by Manley, as modified by Antinone, raised, as taught by Lasprogata, in order to create a pleasing aesthetic effect.

9. Claims 23-25 and 27-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manley (D479,146) in view of Antinone (6,327,749).

Manley discloses the invention substantially as claimed, as set forth above. However, Manley does not disclose indicia on the sleeve. Antinone teaches that it was known in the art to

provide indicia on a sleeve of the type disclosed by Manley. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the sleeve disclosed by Manley with indicia, as taught by Antinone, in order to advertise the subject matter of the indicia.

Regarding claims 24 and 30, see Figs. 1 and 2.

Regarding claims 25 and 31, Manley discloses the invention substantially as claimed, as set forth above. However, it is not known whether an adhesive assists in securing the sleeve to the clip. Nevertheless, it is well known to use an adhesive to secure one thing to another and it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an adhesive between the sleeve and the clip, in order to attach the sleeve to the clip more securely.

Regarding claim 28, Manley discloses the invention substantially as claimed, as set forth above. However, the panels appear to be slightly larger than the outer surfaces of the clip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the panels the same size as the outer surfaces of the clip because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 32 and 33, Manley discloses the invention substantially as claimed, as set forth above. However, it is not known what material is used to make the sleeve. Because it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having

ordinary skill in the art would know that paper or mylar would be suitable for the fabrication of a sleeve, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the sleeve disclosed by Manley from paper or mylar as a matter of choice in design, based on such factors as cost and availability of the materials to the designer.

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manley (D479,146) in view of Antinone (6,327,749), as applied to claim 23, above, and further in view of Will et al. (5,766,795).

Manley discloses the invention substantially as claimed, as set forth above. However, the sleeve apparently does not include a transparent protective layer. Will et al. teaches (see the Abstract) that it was known in the art to provide a transparent protective layer on a label. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the sleeve disclosed by Manley with a transparent protective layer, as taught by Will, in order to protect the sleeve.

#### *Response to Arguments*

11. Applicant's arguments filed March 27, 2006 have been fully considered but they are not persuasive.

Applicant's statement that the independent claims have been amended "to better define Applicant's binder clip sleeve as an indicia-display device and not as an accessory apparel item" (emphasis in original) is not understood. The independent claims have always been drawn to "a tri-panel binder clip sleeve" (claim 1), "a tri-panel binder clip sleeve" (claim 15), "a method of affixing indicia to a binder clip" (claim 23) and "a tri-panel binder clip sleeve" (claim 27). The

claims have never mentioned the phrase “accessory apparel item” and the recent amendments do not pertain to this language either.

Regarding Manley, the fact that Applicant chooses to characterize this device as “an accessory apparel item” is not relevant. As explained above, claims 1 and 3-6 describe the device disclosed by Manley, regardless of that device’s intended use.

Applicant states that “all three cover parts [disclosed by Manley] must be viewed in their totality because to do otherwise would impermissibly alter manly and defeat the purpose of the Manley money clip.” But the Examiner has not proposed altering Manley. The Examiner has merely pointed out that claims 1 and 3-6 describe the device disclosed by Manley. The fact that Manley discloses additional elements, not recited in the claims, is irrelevant.

Applicant states that “claim 1 requires that the handles are uncovered thereby distinguishing Manley.” Rather, claim 1 requires that the first and second panels of the tri-panel binder clip sleeve are “secured to the respective jaw portion” in such a way that they do not cover the handles. This is true in Manley. The tri-panel binder clip sleeve disclosed by Manley does not cover the handles. Additional parts do cover the handles.

Regarding Applicant’s observation that the device disclosed by Manley is “intended to be carried in a user’s pocket,” and therefore would not need indicia, the Examiner replies that many pocket-carried items, e.g., key fobs, feature indicia.

Regarding the size of Manley’s sleeve, it is noted that as long as the sleeve is not smaller than the clip, it will protect items from contact with exposed features of the clip, because none of the clip will be exposed.

*Conclusion*

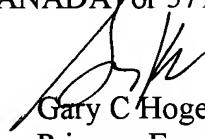
12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gary C Hoge  
Primary Examiner  
Art Unit 3611

gch